

Application No. 10/021,407

REMARKS/ARGUMENTS

Claims 5-8 and 13-18 stand rejected. Claims 5, 8, and 18 are amended. Claims 5-8 and 13-18 remain pending.

Claim Objection: Claims 8 and 18 are amended to overcome the rejection that the claims as originally presented used the word "comprising" instead of "consisting of" in connection with a Markush group.

102 Rejection of Claims 5 and 6

Claims 5 and 6 are rejected as anticipated by US 3,885,561 to Cami. It is respectfully urged that Cami discloses a flexible catheter, not a tubular needle as recited in Claim 5. However, without prejudice to Applicant's ability to file one or more continuation applications, Claim 5 has been amended to recite the tubular needle comprises a non-metallic liner. Support for addition of the non-metallic liner is found on page 8, lines 7-27 of the application. It is respectfully urged that Claim 5, as amended, distinguishes over Cami.

103 Rejection of Claims 5, 13, 14, 15, 18

Claims 5, 8, 13, 14, 15, and 18 are rejected as obvious over US 3606878 (Kellogg) in view of US Patent 6,430,429 (Van Vaals). It is respectfully urged that this rejection is improper for the following reasons.

With respect to Claims 5 and 13, it is respectfully urged that Kellogg and Van Vaals, even if combined do not teach the subject matter of amended Claim 5 and Claim 13 (which depends from Claim 5).

Further, it is respectfully urged that there is no motivation to combine the references as suggested by the Examiner. The Examiner admits that Kellogg fails to disclose (1) a needle being non-metallic, and (2) that Kellogg fails to disclose a distal tip having a cavity, and (3) that Kellogg fails to disclose an artifact creating material disposed in a cavity. So, at minimum, the Examiner admits that the base reference fails to teach or suggest at least three elements of Claims 5, 14, and 15.

Application No. 10/021,407

It is respectfully urged that the Examiner has not shown the required motivation in the prior art to modify Kellogg by the teachings of Van Vaals. In particular, the Examiner has not shown what motivation there would be to modify Kellogg to include at least three elements that the Examiner admits are not present in Kellogg.

It is respectfully urged the Examiner is merely picking and choosing elements from Van Vaals to reconstruct the claimed invention based on improper hindsight reliance on the applicants invention. For instance Claims 14 and 15 recite a needle having a side port spaced from a distal end of a needle, and a sharpened distal tip attached to the distal end of said needle, with the material for leaving the artifact is positioned in the distal tip (and so positioned distal of the side port). It is respectfully urged that Van Vaals does not teach or suggest placement of material with respect to a side port for receiving a tissue sample. Accordingly, it is respectfully urged that it is only on improper hindsight reliance on the applicant's specification that the Examiner concludes one would modify Kellogg by Van Vaals as suggested by the Examiner.

It is respectfully urged that the rejections of Claim 6 and 16 and Claim 7 and based on the combination of Kellogg and Van Vaals, and further in view of Gillies et al. (for Claims 6 and 16) or Werne (for Claims 7 and 17) is improper for at least the reasons set forth above regarding lack of motivation to combine Kellogg and Van Vaals.

Reconsideration and allowance of the Claims is requested. The Examiner is requested to call the undersigned if the Examiner has any question or would like to discuss the claims, as amended.

Respectfully submitted,

/Gerry Gressel/
Gerry Gressel, reg#34,342

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(513) 337-3535
Date: October 13, 2005